

REMARKS

Claims 1 and 5 are pending. The application is presently under continued examination.

Claim 1 is Patentable over Bentsen in view of Kapperman.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bentsen in view of Kapperman. Applicant respectfully traverses the rejection.

The claim in question has been under rejection under 103(a) as allegedly unpatentable over Kapperman in view of Bentsen during the entirety of the examination of this application. Responsive to each rejection in each Office Action, Applicant has amended the claim to clarify the differences between the cited art and the claimed invention. Responsive to the last Office Action and subsequent to an interview with the Examiner, Applicant amended the claim, and submitted over 4 pages of remarks addressing the suitability of Kapperman as a reference and the lack of obviousness even in view of the combination. Applicant respectfully notes that the present Office Action does not even address the Applicant's remarks other than to state that the remarks are moot "in view of the new grounds of rejection".

Applicant further respectfully submits that the new grounds of rejection are based primarily or even purely on impermissible hindsight. The Office Action offers but one sentence to provide motivation for combining the references:

"As it would be beneficial to provide an asymmetric flange structure so as to have a particular asymmetric flexibility to the web structure on the device of Bentsen, it would have been obvious to modify the closure structure of the device of Bentsen so as to maintain the ribs at the margins of the closure members, but to have only a single flange extend from one of the closure members as taught by Kapperman et al. (Figure 1) as being a desirable configuration by providing an asymmetric base on the female member."

Office Action 10/19/2005, page 3, line 7.

Applicants respectfully submit that the italicized alleged motivation does not exist in the references themselves. Further, even if such a motivation could be found in the references, the skilled artisan would not have combined such a feature from the

nonreclosable, interlocking, tamper-evident closure member of Kapperman, with the teachings of Bentsen, to arrive at the solution to the problem provided by the Applicant.

Applicant respectfully asserts that the Office Action has failed to present a proper *prima facie* case for § 103(a) obviousness. In particular, the PTO must, as a matter of law, articulate the basis on which it concludes that it would have been obvious to make the claimed invention.

"In practice, this requires that the Board "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." This entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the Graham test."

In re Leonard Kahn, (Fed. Cir. 2006) (Slip Opinion at 11)(internal citations omitted).

As the court stated in *Kahn*, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Here, the alleged motivation to combine the references cited from the Office Action is merely conclusory.

The Kahn court further clarified that:

In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. See, e.g., *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) ("Although the suggestion to combine references may flow from the nature of the problem, '[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'") (internal citation omitted) (quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998))); *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992)

("[T]he law does not require that the references be combined for the reasons contemplated by the inventor."); *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005) (characterizing the relevant inquiry as "[would] an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention,[] have selected the various elements from the prior art and combined them in the manner claimed"); see also *Graham*, 383 U.S. at 35 (characterizing the problem as involving

mechanical closures rather than in terms more specific to the patent in the context of determining the pertinent prior art). Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See *Cross Med. Prods.*, 424 F.3d at 1321-24. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art—i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention—support the legal conclusion of obviousness. See *Princeton Biochemicals*, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).

Id. at 15-16.

Here, the Office Action does not fully set forth the overall disclosures, teachings and suggestions of the cited art in the context of the problem to be solved. Further, the Office Action ignores the question of whether the skilled artisan would deem Kapperman analogous art. As was detailed in the prior response, Kapperman is directed to a different purpose altogether from the separable and reclosable closures provided in the instant invention, the inventor would accordingly have had significantly less motivation or occasion to even consider it. The Office Action does not consider this in its articulation of a motivation. Still further, the Kapperman disclosure clearly precludes the attachment of the intact (interlocked) closure by a single flange. Kapperman specifically teaches this from column 9, line 56 through column 10, line 11 as was detailed in the prior responsive paper (e.g. see page 5, last paragraph). The skilled artisan seeking to modify the attachment of an intact closure would not look to Kapperman which features separate male and female members which must remain separated until after the construction of the entire package. This discussion is clearly not mooted by the new grounds of rejection, nor is the discussion of Figure 8 in Bentsen on page 6-7 of the prior responsive paper. As surely as Bentsen would not benefit the teachings of Kapperman, the attachment of female member of Kapperman can only benefit the teachings of Bentsen in hindsight, i.e. with the invention in mind. This is clear from the prosecution history of this application. Applicant respectfully submits that only through the post-hoc recombination of the Bentsen and Kapperman references after extended prosecution, while

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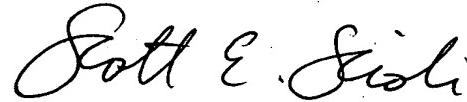
ignoring the short comings and teachings of each as a whole that would eliminate any alleged motivation to combine, and while the problem solved by the inventor is clearly present in the articulated rationale, can the Office Action theoretically arrive at the Applicant's invention – all clear indicia of impermissible hindsight reconstruction.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a). The claims are plainly patentable over Bentsen in view of Kapperman, and vice versa.

Conclusion

The claims are in condition for allowance. An early and favorable Notice to that end is earnestly solicited. The Examiner is invited to resolve any minor issues with Applicant's undersigned representative via telephone during normal business hours at 215-557-5986.

Respectfully submitted,



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